

**Appln No. 10/668,659**

**Amdt date March 14, 2006**

**Reply to Office action of December 15, 2005**

**REMARKS/ARGUMENTS**

Claims 1-3, 6, 11-13, 17 and 19-26 are in the present application, of which claims 1, 19, 20 and 26 are independent. Claims 1-3, 6, 11-13, 17 and 19-20 are amended herein. Claims 4-5, 7-10, 14-16 and 18 have been cancelled without prejudice. New claims 21-26 have been added. No new matter has been added.

Applicant thanks the Examiner for the thorough examination of the application and allowance of claim 20. Applicant also thanks the Examiner for the indication that claims 12-14 and 17 include patentable subject matter. Of the allowed/allowable claims, however, claim 14 is cancelled and claims 12-13, 17 and 20 are amended herein. Applicant respectfully requests reconsideration and allowance of claims 1-3, 6, 11-13, 17 and 19-20. Applicant also requests consideration on the merits and allowance of newly added claims 21-26.

**I. Rejection of Claims 1-5 under 35 U.S.C. § 101**

Claims 1-5 have been rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1, 2, 3, and 5 of prior U.S. Patent No. 6,637,988. Since claims 4 and 5 are cancelled herein, their rejection is now moot. Since claims 1-3 have been substantially amended herein, Applicant requests that the rejection of claims 1-3 under 35 U.S.C. § 101 be withdrawn.

**II. Rejection of Claims 1-3 and 6-11 under 35 U.S.C. § 102(b)**

Claims 1-3 and 6-11 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 2,843,167

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("Rushton"). Since claims 7-10 are cancelled herein, their rejection is now moot.

In rejecting these claims as allegedly being anticipated over Rushton, the Examiner asserts "[r]eferring to figure 3, note the two plates 42 which are moved toward and away from each other by an actuator/differential screw 28 (actuated by handle 36). The lower plate 42 in figure 3 is considered to be a base having a clamping face, and the upper plate is considered to be a clamp body. Both of the plates have clamping faces which grip door 10. The base has a guide carrier 60 having a drill guide 86 which is perpendicular to the plane of the base clamping face." (Emphasis Added)

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

Claim 1 now recites, in a relevant portion, "a guide carrier disposed on said base and having a second clamping face which is substantially perpendicular with respect to said base face; and at least one drill guide in said guide carrier, said drill guide having an axis which angularly intersects said

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second clamping face, said guide carrier being movably mounted on said base to move in a substantially perpendicular direction with respect to said base face to permit drilling at a selected position of a face of the workpiece." (Emphasis Added)

The Examiner appears to equate "bushings 86" with the "at least one drill guide in said guide carrier" in claim 1 of the present application. However, as can be seen in FIG. 3 of Rushton cited by the Examiner, the bushings 86 appear to be perpendicular to the clamping face. In fact, the Examiner agrees that "[t]he base has a guide carrier 60 having a drill guide 86 which is perpendicular to the plane of the base clamping face," as cited above. As such, Rushton does not disclose "said drill guide having an axis which angularly intersects said second clamping face." Since Rushton does not disclose at least one element of claim 1, claim 1 is not anticipated by Rushton. Therefore, Applicant requests that the rejection of claim 1 over Rushton be withdrawn.

Since claims 2-3, 6 and 11 depend, directly or indirectly, from claim 1, they each incorporate all the terms and limitations of claim 1, in addition to other limitations, which together further patentably distinguish claim 1 over the cited references. Therefore, Applicant requests that the rejection of claims 2-3, 6 and 11 be withdrawn. Since claims 2-3 are not otherwise rejected, Applicant requests that claims 2-3 be allowed.

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**III. Rejection of Claims 1, 6, 9, 11 and 15 under 35 U.S.C. § 102(b)**

Claims 1, 6, 9, 11 and 15 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 1,128,970 ("Godefroy et al."). Since claims 9 and 15 are cancelled herein, their rejection is now moot.

In rejecting these claims the Examiner contends "[f]igure 2 shows a guide carrier 22 having a drill insert 28, such that the axis of the insert intersects the plane of the clamping face of the base. The guide carrier 22 is movable along bars 20, 21, in a direction parallel to the [plane] of the clamping face."

Here, the Examiner appears to equate the "slidable portion 22" of Godefroy et al. with the "guide carrier" in claim 1 of the present application. Claim 1 recites in a relevant portion, however, "a base having a base face adapted to engage a workpiece . . . a guide carrier disposed on said base and having a second clamping face which is substantially perpendicular with respect to said base face; and at least one drill guide in said guide carrier . . . said guide carrier being movably mounted on said base to move in a substantially perpendicular direction with respect to said base face to permit drilling at a selected position of a face of the workpiece." (Emphasis Added).

The slidable portion 22 as shown in FIGs. 1 and 2 of Godefroy et al. (which the Examiner appears to equate to the guide carrier) moves along bars 20 and 21 that are positioned parallel to the base face of the base (header 10). As such, the slidable portion 22 of Godefroy et al. moves in a direction that is parallel to the base face. Therefore, Godefroy et al. does not disclose "said

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guide carrier being movably mounted on said base to move in a substantially perpendicular direction with respect to said base face." Therefore, Godefroy et al. does not teach all elements of claim 1, and claim 1 is not anticipated by Godefroy et al. Therefore, Applicant requests that the rejection of claim 1 over Godefroy et al. be withdrawn and that it be allowed.

Since claims 6 and 11 depend, directly or indirectly, from claim 1, they each incorporate all the terms and limitations of claim 1 in addition to other limitations, which together further patentably distinguish them over the cited references. Therefore, Applicant requests that the rejection of claims 6 and 11 over Godefroy et al. be withdrawn and that they be allowed.

#### **IV. Rejection of Claim 19 under 35 U.S.C. § 102(b)**

Claim 19 has been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,076,742 ("Lee et al."). In rejecting claim 19, the Examiner contends that "Figure 3 [of Lee et al.] shows a clamping face 50 on plate 11, guide carrier 13 having drill guide 18, and bit 24 having depth indicia 34. However, in FIG. 3 of Lee et al., the bit 24 appears to have an axis that is normal or perpendicular to the "clamping face 50," and Lee et al. does not disclose "said drill guide having an axis which angularly intersects said plane of said clamping face," (Emphasis added) as recited in claim 19.

Further, claim 19 recites, "indicia disposed on a shank surface of said step drill, wherein said indicia are indicative of workpiece thickness." According to Lee et al., the "depth indicia 34" are "annular rings 34, which are spaced 1 mm apart, can be

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used to locate the position of collar 30 so that the desired depth is obtained." (Col. 4, lines 39-42). As such, the "depth indicia 34" of Lee et al. appear to be indicative of the depth of hole to be drilled, and not of "workpiece thickness."

Since Lee et al. does not disclose at least the above limitations of claim 19, Lee et al. does not anticipate claim 19. Therefore, Applicant requests that the rejection of claim 19 be withdrawn and that it be allowed.

**V. Rejection of Claims 16 and 18 under 35 U.S.C. § 103(a)**

Claims 16 and 18 have been rejected as allegedly being unpatentable over Godefroy et al. in view of U.S. Patent No. 2,490,718 ("Stellin"). Since claims 16 and 18 are canceled herein, their rejection is now moot.

**VI. Allowance of Claim 20**

Claim 20 was previously indicated as allowed. While claim 20 has been amended herein, Applicant believes that claim 20 still includes patentable subject matter. By way of example, none of the cited references, either alone or together in any combination, discloses, teaches or suggests "[a]n adjustable pocket drilling fixture comprising: a clamping face, said clamping face defining a plane; a guide carrier, at least one drill guide in said guide carrier, said drill guide having an axis which intersects said plane of said clamping face; and indicia formed on a surface in-between said plane and an entrance of said drill guide, which has a relationship to said axis, wherein width of said indicia is substantially equal to an

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internal diameter of said drill guide." Therefore, Applicant requests that the allowance of claim 20 be maintained.

**VII. Claims 12, 13, 17 and newly added claims 21-25**

Claims 21-25 have been newly added herein. Since claims 12, 13, 17 and 21-25 depend, directly or indirectly, from claim 1 or claim 20, they each incorporate all the terms and limitations of claim 1 or claim 20 in addition to other limitations, which together further patentably distinguish them over the cited references. Therefore, Applicant requests that claims 12, 13, 17 and 21-25 be allowed.

**VIII. Newly Added Claim 26**

The newly added claim 26 recites, in a relevant portion, "a guide carrier disposed on said base and having a second clamping face which is substantially perpendicular to said base face, and at least one drill guide disposed in said guide carrier, said drill guide having an axis which is adapted to angularly intersect two adjoining surfaces of the workpiece, wherein said clamp actuator is positioned adjacent to said second end of said base so that clamping and drilling the workpiece can be accomplished on the same side." Since the cited references, either alone or together in any combination, do not disclose, teach or suggest at least the above features of claim 26, claim 26 is patentably distinguishable over the cited references. Therefore, Applicant requests that claim 26 be allowed.

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**IX. Concluding Remarks**

In view of the foregoing amendments and remarks, Applicant submits that claims 1-3, 6, 11-13, 17 and 19-26 of the present application are in condition for allowance. Therefore, Applicant earnestly solicits a timely Notice of Allowance. If there are any remaining issues that can be addressed over the telephone, the Examiner is cordially invited to call Applicant's attorney at the number listed below.

Respectfully submitted,

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